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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/076,115    05/12/98    GRUBER

C    0942.4350001

HM12/0317

EXAMINER
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BRIAN J DEL BUONO  
STERNE KESSLER GOLDSTEIN AND FOX  
SUITE 600  
1100 NEW YORK AVENUE NW  
WASHINGTON DC 20005-3934

TUNG, J	
ART UNIT	PAPER NUMBER

1634  
DATE MAILED:

03/17/99

*6*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/076,115

Applicant(s)

Gruber et al

Examiner

Joyce Tung

Group Art Unit

1634

☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1, 2, 6, 12, 16-20, 22, 25, 28, 29, 31-33, 35, 36, 40-45, 49, 51 and 53 are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1, 2, 6, 12, 16-20, 22, 25, 28, 29, 31-33, 35, 36, 40-45 are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1634

### **DETAILED ACTION**

The art unit designated for this application has changed. Applicant(s) are hereby informed that future correspondence should be directed to Art Unit 1634.

#### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1, 2, 6, 12, 16-20, 22, 25, 28, 29, 31, 32 and 41-43, drawn to a method and kit to make nucleic acid, classified in class 435, subclass 91.2.
  - II. Claims 33, 35 and 36, drawn to a nucleic acid comprising one or more primer-adaptor, classified in class 536, subclass 24.2.
  - III. Claim 40, drawn to a nucleic acid, classified in class 536, subclass 22.1.
  - IV. Claims 44-45 and 49, drawn to a method for producing cDNA and mRNA, classified in class 536, subclass 25.4.
  - V. Claim 51, drawn to a method for isolating mRNA, classified in class 536, subclass 25.4.
  - VI. Claim 53, drawn to a method for isolating one or more desired nucleic acid molecule from a population, classified in class 536, subclass 25.4.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions II and III, and I, IV, V and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different

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product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the products in Groups II and III can be used in hybridization assay.

3. Inventions II and III are deferent because Invention II is drawn to a nucleic acid comprising one more primer-adaptor which can be used in amplification, while Invention III is drawn to a nucleic acid which can used in hybridization.

4. Inventions I, IV, V and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as making nucleic acid, Group IV can be used for isolating nucleic acid, Group V can be used in isolating mRNA and Group VI can be used for isolating desired nucleic acid from a population. See MPEP § 806.05(d).

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. A telephone call was made to Mr Brian J. Del Buono on 2/17/99 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (703) 305-7112. The examiner can normally be reached on Monday-Friday from 8:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached at (703) 308-1152.

Any inquiries of a general nature or relating to the status of this application should be directed to the Chemical/Matrix receptionist whose telephone number is (703) 308-0196.

8. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1634 via the PTO Fax Center located in Crystal

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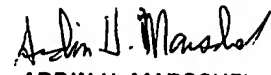
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Mall 1 using (703) 305-3014 or 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Joyce Tung

March 3, 1999

  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER